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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,289	01/17/2002	Stephen O. Clark	45715.830001.000	4897

26582 7590 08/20/2003

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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,289

Applicant(s)

CLARK ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 June 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *the adhesive or suction cup (see claim 3)* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The specification and claim as originally filed requires either the use of adhesive or a suction cup but not together, therefore, it is misleading when both are shown on the same drawing, since it suggests that the two are used in combination.

Specification

2. The use of the trademark VELCRO has been noted in this application as originally filed and in the amendment filed 23 June 2003. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claims 18-21 are objected to because of the following informalities: While there is no statutory form for claims, the present Office practice is to insist that each claim must begin with a capital letter and end with a period (see claim 18). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the newly added limitation “resilient cup, resilient means or resilient bunt aid” and “whereby the resilient cup provides sufficient give to simulate catching a ball with a baseball glove”. What is disclosed in the specification (see page 5, lines 13-25) is as follows: “Often the art of bunting is described as catching the baseball with the baseball bat. Thus, the bunt aid should be made with material having a resiliency similar to a baseball glove. Generally, bunt aid 20 could be made of a rubber or foam, such as neoprene. However, other synthetic or natural material could be used. While resiliency is desirable, the bunt aid 20 should be stiff enough to hold a shape . . . If stiffer materials are used for bunt aid, it would likely be beneficial to line the bunt aid with a foam or rubber material.”. The above statement, merely indicates that different material can be used for the bunt aid 20, that some degree of resiliency is desirable, but the bunt aid should be stiff enough to hold a shape, and that the bunt aid should have a resiliency similar to a baseball glove. The heritage dictionary defines resilient as capable of returning to an original shape or position, as after having been compressed. When claiming “a resilient cup”, it suggests that materials having various degrees

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of resiliency are acceptable for use, but such is in contradiction to the specification and claims as originally filed. What is disclosed in this application as originally filed, does not suggest that the bunt aid can be made of material with different degrees of resiliency. On the contrary, the specification is clear as to the type of material that is suitable for use. With respect to the bunt aid simulating catching a ball with a baseball glove such has not been disclosed in the specification or claims as originally filed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-11, 13-16, 18 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Genjack (3,169,019).

Regarding claim 1, Genjack discloses at least one cup (11); at least one strap (30) attached to the cup (11), wherein the strap is adapted to secure the cup to the bat (25). Genjack is silent as to the material used to make the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. As it is well known both material have some degree of resiliency. The degree of resiliency varies depending on the shore hardness of the material. Regarding the limitation “whereby the resilient cup provides sufficient give to simulate catching a ball with a baseball glove”, this feature is inherently present in Genjack’s device since it is used for catching

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and throwing balls, therefore it simulates a baseball glove, since a baseball glove is used for catching and throwing balls.

Regarding claim 2, Genjack shows the strap is detachably coupled to the at least one cup (see column 2, lines 12-35); and a length sufficient to wrap around the barrel (see figure 1).

Regarding claim 4, Genjack further shows the cup (11) is positionable along the bat (25). See figure 1.

Regarding claim 5, Genjack further shows the cup (11) having a seating surface (20) adapted to be secured adjacent to the bat (25), and sidewalls (13) having a rim, wherein the rim defines an opening (see figures 2 and 6).

Regarding claim 6, Genjack further shows the sidewalls (13) tapering generally outwardly (see figure 4).

Regarding claim 7, Genjack shows the seating surface having a substantially funnel shape (see figure 2).

Regarding claims 8 and 9, Genjack also show the opening defining a geometrical shape such in a circle (see figure 2).

Regarding claim 10, Genjack shows the seating (20) having an opening (33).

Regarding claim 11, as best seen from figures 2 and 3, Genjack shows the cup having a rim and the rim having a lip portion which has an outer, inner and transition portion and generally parallel to the bat surface (see figure 1).

Regarding claim 13, see comments for claim 1.

Regarding claim 14, Genjack further shows the device to be used for catching a ball, which would inherently direct the bat towards the ball upon impact (see column 1, lines 14-16).

Regarding claim 15, see comments for claim 4.

Regarding claim 16, Genjack's cup upon catching or impacting a ball would inherently deaden the impact of the ball on the bat.

Regarding claim 18, see comments for claim 1. Additionally, Genjack shows the cup being attached to a bat (see figure 1), wherein the bat has a handle portion, a barrel portion and an intermediate portion.

Regarding claim 20, see comments for claim 2.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 12, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genjack (3,169,019).

Regarding claim 3, Genjack shows the strap to be a continuous loop. Official Notice is taken that modifying a continuous loop strap (one-piece) to a two-part strap would have been an obvious choice of design and it would have been obvious to do so here, since it would make the device more readily detachable.

Regarding claim 12, Genjack is silent as to the material used for making the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. Absent a showing of new or

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unobvious results, it would have been obvious to use any well-known material including rubber, foam, leather, metal, wood, etc. for the cub of Genjack, depending on the availability and the suitability of the material, and it would have been obvious to do so here.

Regarding claim 19, Genjack shows the cup or bunt aid (11) to be releasably attached to the bat. It would have been obvious to one of ordinary skill in the art to have made the cup integral with the bat, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re Larson* 144 USPQ 347 (CCPA 1965), and it would have been obvious to do so here, since it would require less parts.

Regarding claim 21, see comments for claim 12.

10. Claims 13, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tyner (6,254,498).

Regarding claim 13, Tyner shows an instructional device (10) having resilient means (15; see column 4, lines 16-26) to improve bunting skills; the means for simulating the catching of a ball with the bat; and means for attaching the simulating means to the bat (see column 5, lines 1-7).

Regarding claim 14, Tyner shows the simulating means (15) is positioned on the bat in order to strike a ball, therefore, it would inherently guide the bat to the ball.

Regarding claim 16, Tyner shows the means for simulating (15) would inherently deaden the impact of the ball on the bat.

Regarding claim 17, Tyner further shows the instructional device (15) adjustably positioned on a training bat (10), wherein the means to simulate is a sleeve (see figure 3).

Response to Arguments

11. Applicant's arguments filed 23 June 2003 have been fully considered but they are not persuasive. The features that applicant relies upon are new matter, and have not been disclosed in this application as originally filed. Referring to figures 4 and 6, of Genjack, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. As it is well known both material have some degree of resiliency. The degree of resiliency varies depending on the shore hardness of the material. Regarding the limitation "whereby the resilient cup provides sufficient give to simulate catching a ball with a baseball glove", this feature is inherently present in Genjack's device since it is used for catching and throwing balls, therefore it simulates a baseball glove, since a baseball glove is used for catching and throwing balls. No arguments or comments were presented by applicant regarding the rejection of claims 13, 14, 16 and 17 under 35 U.S.C. 102(b) as being anticipated by Tyner (6,254,498).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA
15 August 2003


[Paul T. Sewell]
Supervisory Patent Examiner
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